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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,232	02/14/2000	PHILIP JOHN BIGGS	BW-398-2	2011

7590 01/16/2004

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EXAMINER
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LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/446,232	BIGGS ET AL. 	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-17 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-17 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1) Claims 1,4-15, and 31-34 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Gibson et al (US 3878850). Gibson discloses a smoking material having a non-polyol aerosol generator, up 20% by weight tobacco, binder and inorganic filler (Column 4, lns. 34-46). As for claims 4-5, the non-polyol aerosol generator being glycerol triacetate, 5% by weight (Column 4, lns. 34-46). As for claims 6-8, 14 and 33, the inorganic filler, comprising among other things calcium carbonate, contains 45% in weight (Column 4, lns. 34-46). As for claims 9 and 10, there is no tobacco present in the smoking material, 0% (Column 4, lns. 34-46). As for claims 11-13, and 15 34, the binder, carboxymethyl cellulose, being present not more than 20% (Column 4, lns. 34-46). The instant specification as originally filed does not show a patentable distinction between 5 and 6% non-polyol aerosol generator. Additionally, glycerol triacetate is a compound shown by Gibson et al to provide desired effects in the smoke profile (Column 4, lines 51-62). Hence, it would have been obvious to a person of ordinary skill in the art to have increased the amount of glycerol triacetate from 5% to 6% in order to increase the benefits disclosed by Gibson et al.
- As for claim 32, a polyol aerosol generator is present at 8.5% (Example 1).

The newly added limitation of 5 to 20% tobacco is deemed to be met by Gibson et al when considering Gibson's material (substrate) is blended with up to 80% tobacco. Gibson's substrate blended with up to 80% tobacco as recited in claim 3 of Gibson and in Col.1 line 67, is deemed as the claimed smoking material and thus the claimed 5-20% is clearly envisaged by Gibson.

2) Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850). As disclosed above Gibson meets all the limitations of claim 1, from which claims 16 and 17 are dependent on. Gibson is silent on using an expansion medium or high oil containing materials. However, Gibson teaches that said smoking material may contain flavourants. It is well known in the art that cocoa, having high fat content, is used as a flavourant. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included flavourants as taught by Gibson such as cocoa, as conventionally used in the art, to enhance the smoking experience.

#### ***Response to Arguments***

Applicant's arguments filed 11/04/03 have been fully considered but they are not persuasive. Applicant traverses the rejections made to claims 1, 4-15, and 31-34 under 35 U.S.C. 103(a) over Gibson. Applicant argues that Gibson's goal is to have a high acid base ratio in the smoking article and hence a low inorganic filler content is desired. Applicant designates the term "inorganic filler" as only encompassing calcium carbonate. However, it is noted that the claimed "inorganic filler" not only may include calcium carbonate but also the magnesite and bentonite added to the smoking composition, which using applicant's math expression in page 9 line 10 would result in an inorganic filler content of about 45% (as previously noted in the prior

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rejection). Said inorganic filler weight percentage is calculated by dividing the sum of calcium carbonate, magnesite and bentonite (8.87 parts) by the sum of the total parts making up the smoking composition (19.97 parts). Hence the argued distinction that Gibson only provides for an inorganic filler for which applicant only considers calcium carbonate as an inorganic filler content on average of 15% is moot since the language recited in the instant claims encompasses not only calcium carbonate but also magnesite and bentonite for which would result in the claimed inorganic filler content of at least 30% by weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L.  
January 7, 2004



PETER CHIN  
PRIMARY EXAMINER